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09/602,198	06/22/2000	Theodore G. Habing	068757.P063C	8408

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EXAMINER
HWANG, VICTOR KENNY

ART UNIT	PAPER NUMBER
3764	

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/602,198	HABING ET AL.	
	Examiner	Art Unit	
	Victor K. Hwang	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-9 and 11-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-9 and 11-31* is/are rejected.

7)☒ Claim(s) *2,11,15,18 and 20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 2, 11, 15, 18 and 20 are objected to because of the following informalities:

claim 2 (Three Times Amended), line 6, the second occurrence of "axis" presumably should be changed to --axes--;

claim 2 (Three Times Amended), line 10, "longitudinally" presumably should be changed to --longitudinal--;

claim 11 (Three Times Amended), line 10, "longitudinally" presumably should be changed to --longitudinal--;

claim 15 (Amended), line 5, the second occurrence of "axis" presumably should be changed to --axes--;

claim 15 (Amended), line 9, "longitudinally" presumably should be changed to --longitudinal--;

claim 18 (Amended), line 6, the first occurrence of "axis" presumably should be changed to --axes--;

claim 18 (Amended), line 10, "longitudinally" presumably should be changed to --longitudinal--; and

claim 20 (Amended), line 8, "longitudinally" presumably should be changed to --longitudinal--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2, 11, 15, 18 and 20, the recitation that the longitudinal position of each distal end relative to the longitudinal axis is maintained is indefinite because the longitudinal axis itself moves as the main arm member is moved. Presumably, the longitudinal axis is a static longitudinal axis that is defined in the at rest position.

In claim 11, the recitation that the main arm member is caused to pivot about the main pivot on the last four lines of the claim is indefinite because the main pivot of the main arm member is not connected to anything and so it is not clear that the main arm member is caused to pivot about the main pivot.

In claims 22, 24, 26, 28 and 30, the recitation that the secondary pivots are laterally separated by a distance substantially equal to or greater than a distance extending between a pair of shoulder joints of an intended user sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 2-4, 6-8, 11-13, 15, 16, 18, 20 and 22-31 are rejected under 35 U.S.C. 102(e) as being anticipated by *Ish, III* (US Pat. 5,779,601). *Ish, III* discloses an exercise apparatus comprising a frame 11; a press arm 25 pivotally coupled to the frame, the press arm having a main arm member 25 depending from a main pivot 26a on the frame (the orientation of the main arm member is adjustable such that it can be inclined or declined relative to horizontal, see Figs. 7A and 7B) and a pair of secondary arms 124 coupled to the main arm member at respective secondary pivots 126, wherein the main pivot and each of the secondary pivots has a respective pivot axis and wherein the pivot axis of the secondary pivots are substantially orthogonal to the pivot axis of the main pivot, and wherein each of the secondary arms pivot both inwardly and outwardly from an pendulous at rest position about a respective one of the secondary pivots along an arcuate path that is fixed relative to the main arm member, the at rest position located at a start position for a straightforward chest press, and wherein each of the secondary arms are suspended when at rest; a source of exercise resistance 17; and a means for coupling the source of exercise resistance to the press arm. The source of exercise resistance comprises a weight 17. The means for coupling the source of exercise resistance to the press arm comprises a cable 56. The main arm member includes a transverse cross member 50. The secondary pivots are disposed at opposite ends of the transverse cross member. Each of the main and secondary pivots has a respective pivot axis and the pivot axes

of the secondary pivots are parallel to each other and orthogonal to the pivot axis of the main pivot.

From an at rest position of the secondary arms, as shown in Fig. 12, a longitudinal axis can be oriented perpendicular to the secondary pivot axes and perpendicular to the main pivot axis, wherein each secondary arm has a distal end, wherein movement of the distal ends inward toward one another while maintaining a longitudinal position of each distal end relative to the longitudinal axis causes the main arm member to pivot about the main pivot. As seen in Fig. 12, inward movement of the secondary arms without pivotal movement of the main arm member about the main pivot would locate the distal ends of the secondary arms further along the longitudinal axis away from the main pivot axis. If the longitudinal axis is assumed to be static and doesn't change as the main arm member is pivoted about the main pivot axis, then a pivoting of the main arm member and secondary arm members about the main pivot axis would locate the distal ends of the secondary arms inward along the longitudinal axis toward the main pivot axis. Therefore, in order to maintain the distal ends of the secondary arms at a desired location along the static, at rest, longitudinal axis, the secondary arms are moved inward and the main arm member must also pivot about the main pivot axis.

The secondary pivots are laterally separated by a distance substantially equal to or greater than a distance extending between a pair of shoulder joints of an intended user. As can be seen in Fig. 2, which is top view of the exercise apparatus, the width of the main arm member 25 is substantially equal to the width of the bench 15. A bench upon which a user is supine typically has a width substantially equal to the distance between a pair of shoulder joints of a user, in order to provide full support for a user's back. The secondary arms pivot both

inwardly and outwardly along an arcuate path to at least a straight press exercise start position and a butterfly exercise position.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2-4, 6-9 and 11-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Simonson* (US Pat. 5,643,152). *Simonson* discloses an exercise apparatus comprising a frame 10; a press arm 50,60 pivotally coupled to the frame, the press arm having a main arm member 31,47 depending from a main pivot 30 on the frame and a pair of secondary arms 60 coupled to the main arm member at respective secondary pivots 32,34, wherein the main pivot and each of the secondary pivots has a respective pivot axis and wherein each of the secondary arms pivot about a respective one of the secondary pivots along an arcuate path that is fixed relative to the main arm member; and a weight 23 coupled by a cable 40 to the press arm. Each of the two arms extend at an oblique angle relative to the respective one of the secondary pivot axis. The secondary arms are pendulous when in the at rest position located at the start for a straightforward chest press. The secondary pivots are substantially inclined with respect to vertical. The main arm member includes a transverse cross member 31 with the secondary pivots disposed at opposite ends of the transverse cross member. The secondary pivots are

laterally separated by a distance substantially equal to or greater than a distance extending between a pair of shoulder joints of an intended user.

From an at rest position, relative to a longitudinal axis oriented perpendicular to the secondary pivot axes and perpendicular to the main pivot axis, movement of the distal ends of each secondary arm inward toward one another while maintaining a longitudinal position of each distal end relative to the longitudinal axis causes the main arm member to pivot about the main pivot. The secondary arms 60 are pivotal inwardly from an at-rest position, shown in Fig. 6. As the secondary arms are pivoted inwardly, the distal ends of the secondary arms follow an arcuate path to move them away from the main pivot axis along the longitudinal axis X-X. Presumably, the longitudinal axis is static and remains in the at-rest position. When the main arm member and secondary arms are pivoted about the main pivot axis, the distal ends of the secondary arms follow an arcuate path such that they move relative to the static, at-rest, longitudinal axis closer to the main pivot axis. Therefore, the distal ends of the secondary arms can follow a path perpendicular to the longitudinal axis to maintain a longitudinal position by pivoting inwardly about the secondary axes and pivoting about the main pivot.

Simonson does not disclose in the preferred embodiment, the pivot axes of the secondary pivots being substantially orthogonal to the main pivot axis of the main pivot and each of the secondary arms pivoting both inwardly and outwardly from an at rest position (claims 2, 11, 15, 18 and 20); and the secondary arms pivotal to a butterfly exercise start position (claims 23, 25, 27, 29 and 31).

Simonson discloses that the secondary axes can be oriented at any angle relative to the main pivot axis, including orthogonal to the main pivot axis as shown in Figs. 8-12, 14, 14A,

15, 15A, 16, 18-20 and 25. As shown in at least Fig. 9, the secondary arms 91 can move inwardly and outwardly from an at rest position. Fig. 12 shows the secondary arms 121 moving outwardly against a resistance, but may also rotate inwardly against a resistance (col. 13, lines 60-62). In Figs. 14, 14A, 15, 15A, a spring resistance is attached to the secondary arms to resist inward and outward movement with bi-directional resistance. It would be necessary for the secondary arms, when at-rest, to be in a neutral position where the inward resistance and outward resistances provided by the springs is balanced, such that the secondary arms can be moved both inwardly and outwardly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that the secondary pivot axes of *Simonson* be oriented orthogonal to the main pivot axis, in order to provide lateral movement of the secondary arms independent of the main arm member (col. 7, lines 31-46) and that the secondary arms may be moveable inwardly and outwardly from an at-rest position, in order to provide a comfortable starting position for an exercise. A butterfly start position would be possible.

7. Claims 2-8, 11-13, 15, 16, 18, 20 and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Voris* (US Pat. 5,370,595) in view of *Ish, III* (US Pat. 5,779,601). *Voris* discloses a frame 12; a press arm 60 pivotally coupled to the frame, the press arm having a main arm member 62 depending from a main pivot on the frame and a pair of secondary arms 74 coupled to the main arm member; and a weighted exercise resistance 64 coupled by a cable 66 passing over pulleys rotatably mounted on the main arm member. The

secondary arm members are spaced laterally by a distance substantially equal to or greater than a distance extending between a pair of shoulder joints of an intended user.

Voris does not disclose the secondary arm members coupled to the main arm member at respective secondary pivots, wherein the main pivot and each of the secondary pivots has a respective pivot axis and wherein the pivot axes of the secondary pivots are substantially orthogonal to the pivot axis of the main pivot, and where each of the secondary arms pivot both inwardly and outwardly from an at rest position about a respective one of the secondary pivots along an arcuate path that is fixed relative to the main arm member; and along a longitudinal axis oriented perpendicular to the secondary pivot axes and perpendicular to the main pivot axis, wherein each secondary arm has a distal end, wherein movement of the distal ends inward toward one another while maintaining a longitudinal position of each distal end relative to the longitudinal axis causes the main arm member to pivot about the main pivot (claims 2, 11, 15, 18 and 20); the secondary pivots disposed at opposite ends of the transverse cross member (claims 7 and 13); the secondary pivots substantially parallel to each other (claims 8 and 11); the secondary pivots spaced laterally by a distance substantially equal to or greater than a distance extending between a pair of shoulder joints of an intended user (claims 22, 24, 26, 28 and 30); and the secondary arms pivoting both inwardly and outwardly along an arcuate path to at least a straight press exercise start position and a butterfly exercise start position (claims 23, 25, 27, 29 and 31).

Ish, III has been discussed above, and such discussion is incorporated herein. *Ish, III* discloses providing secondary arms 124 with a pair of secondary pivots 126 having axes substantially orthogonal to the main pivot axis and parallel to each other such that the

secondary arms pivot both inwardly and outwardly from an at-rest position to permit a more natural pushing motion (col. 7, line 18). The secondary arms can be pivoted to start positions for a straight press exercise or to a butterfly exercise.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the press arm of *Voris* with secondary pivots, since *Ish, III* teaches that the secondary pivots permit a more natural pushing motion (col. 7, line 18).

Response to Arguments

8. Applicant's arguments with respect to claims 2-9 and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's statement that "inward movement of the distal ends 108 of the secondary arms 30 is resisted by a resistance source 16 coupled to the main arm member 24" in the second paragraph of section I, the secondary arms are not resisted in their pivotal movement. The secondary arms 30 are freely pivotal about their respective secondary pivot axes 28. As clarified in the next paragraph, resistance to the inward pivotal movement of the secondary arms occurs when the distal ends of the secondary arms are forced to follow a path perpendicular to a defined longitudinal axis. Even this resistance is questioned by the Examiner, since there is still no lateral component to the resistance, but only the longitudinal resistance provided by pivoting of the main arm about the main pivot. The resistance felt by a user may be a perceived lateral resistance, since a lateral path perpendicular to the defined longitudinal axis would require pivoting of the main arm member against the exercise resistance.

In response to Applicant's argument in section II that the secondary arms of *Ish, III* cannot be moved laterally inward while maintaining a longitudinal position of each distal end 108 relative to the longitudinal axis 100 as taught and claimed, the Examiner disagrees. As discussed above in the rejection of paragraph number 4, the distal ends of the secondary arms move away from the main pivot relative to the defined longitudinal axis as the secondary arms are pivoted inwardly from an at rest position shown in Fig. 12. As the main arm member and secondary arms are pivoted about the main pivot, the distal ends move closer to the main pivot axis relative to the defined longitudinal axis. Therefore, in order for the distal ends of the secondary arms to follow a path perpendicular to the defined longitudinal axis to maintain a longitudinal position, the secondary arms and main arm member must be pivoted about the main pivot if the distal ends are moved inwardly. The resistance to inward movement of the secondary arms of *Ish, III* is the same as the resistance to inward movement of the secondary arms of the instant invention.

In response to Applicant's argument in section III that the secondary arms of *Simonson* have no lateral component of resistance when the secondary pivots are at 90 degrees relative to the main pivot axis the Examiner agrees, but Applicant's invention also has no lateral component of resistance. Like Applicant's invention, the secondary arms of *Simonson* can be moved inwardly and in order to maintain a longitudinal position of the distal ends relative to the defined longitudinal axis, the secondary arms and main arm member must be pivoted about the main pivot. Further explanation is provided in the rejection of paragraph number 6.

In response to Applicant's argument that the secondary arms of *Simonson* can only be pivoted inwardly from an at rest position, *Simonson* discloses at least in Figs. 9, 12, 14, 14A,

15 and 15A secondary arms that move inwardly and outwardly from an at rest position. Regarding the bracket 37 that defines the lateral starting position of the preferred embodiment, the disclosed obvious modifications provide for inward and outward movement of the secondary arms from an at rest starting position. With the secondary pivots oriented orthogonal to the main pivot, the secondary arms would hang in an at-rest position such that the secondary arms are substantially parallel to one another and negate the need for the bracket to limit the outward movement of the secondary arms and the counterweights weighted to keep the secondary arms biased against the brackets. Further clarification is also provided in the rejection of paragraph number 6.

In response to Applicant's argument in section V.1 that *Ish, III* does not teach movement of the distal ends of the secondary arms inward toward one another while maintaining a longitudinal position of the distal ends, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). *Ish, III* is capable of performing the intended movement as described in Examiner's response above.

In response to Applicant's argument in section V.2 that *Simonson* provides secondary arms having no lateral resistance component when the secondary pivots are oriented at 90 degrees relative to the main pivot, Applicant's secondary arms function in the same manner.

Applicant's secondary arms can be moved laterally without encountering any resistance. Perhaps Applicant's understanding of the term "laterally" is different than the use of the term by *Simonson*. The term "laterally" as used by *Simonson* is interpreted to mean movement towards or away from a centerline of the apparatus. Applicant is interpreting the term "laterally" as used by *Simonson* to mean movement towards or away from a centerline of the apparatus in a path limited to being perpendicular to the centerline of the apparatus or Applicant defined longitudinal axis. In response to Applicant's argument that inward and outward movement of the secondary arms of *Simonson* from an at-rest position is not taught or suggested by *Simonson*, Applicant is directed to at least Figs. 9, 12, 14, 14A, 15 and 15A and their corresponding descriptions in the specification which teach and suggest inward and outward movement of the secondary arms. Furthermore, claim 20 lacks the limitations that Applicant argues.

In response to Applicant's arguments in section VII that *Ish, III* and *Simonson* do not teach secondary arms pivotal to a butterfly exercise start position, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The secondary arms of *Ish, III* and the suggested secondary arms of *Simonson* are fully capable of being positioned to the start position of a

butterfly exercise. The actual movement of the distal ends of the secondary arms may be different from thereout, but the start position is the same.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davenport (US Pat. 4,465,274), *Tatom* (US Pat. 4,773,398), *Stearns* (US Pat. 5,094,449), *Fuller, Sr.* (US Pat. 5,637,063) and *Ellis et al.* (US Pat. 6,302,833 B1) disclose exercise apparatus having secondary arms pivotally movable inwardly and outwardly from an at-rest position.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (703) 308-2865. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time. The facsimile number for submitting papers directly to the examiner for informal correspondence is (703) 746-4891. The facsimile number for submitting Official papers to Technology Center 3700 is (703) 872-9302 and for submitting papers After Final to Technology Center 3700 is (703) 872-9303.

Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3700 receptionist at (703) 308-0858.

Victor K. Hwang
March 5, 2003

Jerome W. Donnelly
Primary Examiner

Jerome W. Donnelly
Primary Examiner